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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,216	02/25/2004	Yuichi Yamato	Furuta Case 44	3043
23474	7590	11/16/2005	EXAMINER	
FLYNN THIEL BOUTELL & TANIS, P.C. 2026 RAMBLING ROAD KALAMAZOO, MI 49008-1631			CHANG, VICTOR S	
			ART UNIT	PAPER NUMBER
			1771	
DATE MAILED: 11/16/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/786,216	<b>Applicant(s)</b> YAMATO ET AL.	
	<b>Examiner</b> Victor S. Chang	<b>Art Unit</b> 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.  
     4a) Of the above claim(s) 7,8 and 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Election/Restrictions*

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Filler

- a. as set forth in claims 7 and 10;
- b. as set forth in claim 8;
- c. as set forth in claim 9.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-6 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Terryence Chapman on 8/19/2005 a provisional election was made without traverse to prosecute the invention of species c, claims 1-6 and 9. Affirmation of this election must be made by applicant in replying to this Office action. Claims 7, 8 and 10 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

#### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-6 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claim 1 is generally narrative and indefinite, failing to conform with current U.S. practice. It appears to be a literal translation into English from a foreign document and is replete with grammatical and idiomatic errors. Specifically, the phrase "and heating the molded rubber to cause vulcanization or crosslinking therein", at lines 5 and 6, is redundant to the same phrase at lines 3 and 4. Correction or clarification is requested.

Also, in claim 2, the term "types" is vague and indefinite, because it is unclear what is the scope of the expression was intended to convey.

Additionally, in claim 3, the phrase "major component" is indefinite, because it is again unclear what is the intended scope.

Finally, in claim 9, it is unclear what are the scopes of the terms "HA" and "UHF". Clarification and support are requested.

### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by Itoh et al. (US 4201698).

Itoh's invention is directed to rubber compositions curable to rubbery elastomers by heating, in which an organic rubber, e.g. natural rubber or an organic synthetic rubber, such as butadiene-acrylonitrile rubbers (NBR), etc., and an organopolysiloxane rubber can be co-vulcanized (abstract; column 2, lines 59-67). The rubber composition prepared can be molded and vulcanized to form cured rubbery elastomers, using conventional rubber processing techniques, such as extrusion molding, etc. (column 6, lines 44-47). It should be noted that the preamble "applicator for cosmetics" has not been given patentable weight, because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951). Finally, the Examiner notes that the limitation "extrusion molded into plural layers integrally combined together", in claim 2, is taken as claiming a unitary (integrally combined) molded article.

Claims 1-3 lack novelty.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Itoh et al. (US 4201698) in view of Morrill (Rubber Technology, pages 304-309), and evidenced by Kamiya (US 4061693).

The teachings of Itoh are again relied upon as set forth above.

For claim 4, Itoh is silent about the range of acrylonitrile content in NBR, and the use of NBR for cosmetic application. However, it is noted that Morrill teaches the NBR technology in general, and Morrill expressly shows in Table 12.1 that various properties, such as oil resistance, hardness, resilience, etc., of NBR are related to acrylonitrile wt% in the copolymer. Further, it is known that NBR is a suitable polymer for cosmetic contact, as evidenced by Kamiya's disclosure that acrylonitrile resins have gain acceptance as receptacles for cosmetics (column 1, lines 8-11). As such, in the absence of unexpected results, it would have been an obvious selection to one of ordinary skill in the art to select a suitable NBR grade, motivated by the desire to obtain required physical properties for end application, such as oil resistance and resilience required for articles in contact with cosmetic products.

10. Claim 5 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Itoh et al. (US 4201698).

The teachings of Itoh are again relied upon as set forth above.

For claim 5, Itoh is silent about the method heating, however, since the method limitations have not been shown on the record to produce a patentably distinct article, the formed articles are rendered *prima facie* obvious. It should be noted that product-

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by-process claims are product claims and that to be limiting in a product claim, a process limitation must be evidenced as effecting the structure or chemistry of the resultant product over the prior art. Further, the burden of proof for this showing is on Applicant after the Examiner presents an otherwise *prima facie* rejection. See MPEP § 2113.

11. Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zimmerman (US 2317662) in view of Itoh et al. (US 4201698), and evidenced by Kamiya (US 4061693).

The teachings of Itoh are again relied upon as set forth above.

For claims 6 and 9, it is noted Zimmerman's invention is directed to a cosmetic applicator formed of "foam" type rubber (page 1, right column, lines 35-40), and it is also well known that NBR is a suitable rubber for cosmetic application, as evidenced by Kamiya's disclosure, as set forth above. Further, Itoh also expressly teaches that suitable curing agents include organic peroxides (column 6, lines 10-17). The amount of reinforcing siliceous filler is in the range of 5 to 200 parts by weight per 100 parts by weight of rubber component (column 6, lines 1-6), and, if necessary, in combination with other non-reinforcing or non-siliceous fillers, such as calcium carbonate, etc. (column 5, lines 63-68). In Table VI, Itoh shows examples of using about equal amount of calcium carbonate and siliceous fillers. Finally, it is noted that Itoh lacks a teaching that the article is a sponge puff obtained by providing a blowing agent. As such, in the absence of unexpected results, it would have been an obvious selection to one of ordinary skill in the art to use Itoh's rubber composition to make the foamed cosmetic applicator of



Zimmerman. It should be noted that the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. Finally, regarding the product-by-process limitation "obtained by providing ... a blowing agent" in claim 9, the Examiner notes that since the method limitations have not been shown on the record to produce a patentably distinct article, the formed articles are rendered *prima facie* obvious.

### **Conclusion**

**12.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S. Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H. Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "V. S. Chang", written in a cursive style.

Victor S Chang  
Examiner  
Art Unit 1771

11/10/05